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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,123	07/10/2000	William N. Schilit	FXPL-01022US0 MCF/TAW	8793
23910	7590	09/20/2004	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			HALIM, SAHERA	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/613,123	SCHILIT ET AL.	
	Examiner	Art Unit	
	Sahera Halim	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to communication filled on July 2, 2004.
2. Claim 9 has been cancelled.
3. Claims 1, 10 and 11 have been amended.
4. Claims 1-8 and 10-14 are pending.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "the remainder of the content portion not associated with at least one new link indications not displayed on the display of the mobile device" tends to define the invention in terms of what it is not, rather than pointing out to the invention (see *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953); *id.* mem., 738 F.2d 453 (Fed. Cir. 1984)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Boor et al., U.S. Pat. No. 6,675,204 (hereinafter Boor) in view of Horowitz et al., U.S. Pat. No. 6,122,647 (hereinafter Horowitz).

9. Regarding claim 1, Boor discloses a method for proving data detection from Web content information for mobile devices comprising (abstract):

receiving a URL from a user (col. 4, lines 7 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 7 - 46);

Boor fails to disclose detecting a content portion from the Web page data file, the content portion adapted to be enhanced by introducing at least one new link indication to a service;

searching the content portion to identify Web content data, the web content data included in the content portion and adapted to be accessed to provide at least one new link service from a mobile device through a wireless connection;

displaying the identified web content data using the at least one new link indication on a display.

However, Horowitz teaches detecting a content portion from the Web page data file, the content portion adapted to be enhanced by introducing at least one new link indication to a service (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

Searching the content portion to identify Web content data, the web content data included in the content portion and adapted to be accessed to provide at least one new link service from a device (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

displaying the identified web content data using the link indication on a display (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d).

It would have been obvious for person having ordinary skill in the art at the time of the invention to combine Boor and Horowitz teachings in order to allow easy access of content from mobile devices (Boor, col. 1 line 22 – col. 2, line 28).

10. Regarding claim 2, Boor teaches the steps of providing a user keypad selection enabling the link indication to be activated; and using the wireless connection to activate the link indication when the user keypad selection is made (col. 1, lines 64 – col. 2, lines 28, col. 6, lines 39 – col. 7, lines 39) .

11. Regarding claim 3, Boor discloses the Web content data is a telephone number, (col. 13, lines 28 – line 58).

12. Reference to claim 4, Boor and Horowitz fail to teach the link indication is activated by dialing the number. However, this feature is well known and would have

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been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of dialing a number.

13. Regarding claim 5, Boor discloses the web content data is an address number (col. 13, lines 28 – line 58).

14. Reference to claim 6, Boor and Horowitz do not teach the link indication is activated by obtaining map data showing a location for the address. However, this is an obvious modifications to the systems discloses by Boor and Horowitz. It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Horowitz and Boor by providing a link to an address and then mapping the location in order to simplify the complexity of the system and increase user satisfaction by enabling the user to retrieve needed information from the same web page.

15. Regarding claim 7, Boor discloses the Web content data is an e-mail address (col. 13, lines 28 – line 58).

16. Reference to claim 8, Boors and Horowitz do not disclose the link indication is activated to enable the e-mail to be initiated. However, this feature is well known and would have been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of initiating e-mails.

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17. Regarding claim 12, Boor discloses the display is provided on a device consisting of one or more of the following:

an Internet phone (col. 13, lines 28 – line 58, col. 4, lines 47 – 62 and col. 8 lines 41 – col. 9, lines 55);

a personal digital assistant (col. 13, lines 28 – line 58); and

a two way pager (col. 13, lines 28 – line 58).

18. Reference to claims 13 and 14, Boor teaches the detection occurs in a network server and within a Web browser (col. 9 lines 58 – col. 11, line 53).

19. Regarding claim 10, Boor discloses receiving a URL from a user (col. 4, lines 18 – 46);

accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);

identifying at least one address from the web content data in the Web page data file (col. 13, lines 26 – 51);

displaying the identified address for the user (col. 13, lines 26 – 51);

providing a user keypad selection of a mobile device (Fig.1, col. 9, lines 34 – 49 and col. 4, lines 18 – 46).

Boor does not teach detecting a content portion from the Web page data file;

searching the content portion to identify Web content data, the web content data included in the content portion. However, Horowitz teaches detecting a content portion from the Web page data file (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

searching the content portion to identify Web content data, the web content data included in the content portion (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d). It would have been obvious for person having ordinary skill in the art at the time of the invention to combine Boor and Horowitz teachings in order to allow easy access of content from mobile devices (Boor, col. 1 line 22 – col. 2, line 28).

Moreover, Boor and Horowitz do not teach a map to be provided showing a location for the identified address.

However, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system by providing a map for the identified address in order to increase user satisfaction by providing more information and functionality.

20. Regarding claim 11, Boor discloses receiving a URL from a user (col. 4, lines 18 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);

identifying at least one email address from the web content data in the Web page data file (col. 13, lines 26 – 51);

displaying the identified email address for the user (col. 13, lines 26 – 51);

providing a user keypad selection of a mobile device (Fig. 1, col. 9, lines 34 – 49 and col. 4, lines 18 – 46).

Boor does not teach detecting a content portion from the Web page data file;

searching the content portion to identify Web content data, the web content data included in the content portion. However, Horowitz teaches detecting a content portion from the Web page data file (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

searching the content portion to identify Web content data, the web content data included in the content portion (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d). It would have been obvious for person having ordinary skill in the art at the time of the invention to combine Boor and Horowitz teachings in order to allow easy access of content from mobile devices (Boor, col. 1 line 22 – col. 2, line 28).

In addition Boor and Horowitz do not disclose an email initiation. However, email initiation is well known in the art and it would have been an obvious modification to the system in order to enhance user satisfaction by providing more functionality to the system.

Response to Arguments

21. Applicant's arguments filed July 2, 2004 have been fully considered but they are not persuasive.

The applicant argues that “the hyperlinks provided by Horowitz are associated with more content, not a service”. Providing more content is a service.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reducing pages or displaying portions of data presented on web pages on the mobile communications devices) are not recited in the rejected claim(s). Although the claims

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are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments in regards to newly added limitations of "not disclosing the remainder of the content portions", the examiner asserts that this limitation is negative and renders the claim indefinite (See the above detailed rejection under 112).

22. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim
Patent Examiner
AU: 2157

September 7, 2004



SALEH NAJJAR
PRIMARY EXAMINER